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In re Application of :
PAEK, Seungyup *et al* :
U.S. Application No.: 09/831,215 :
PCT No.: PCT/US99/26127 :
Int. Filing Date: 05 November 1999 :
Priority Date: 05 November 1998 :
Docket No.: 32282-PCT-USA 070050.1164 :
For: IMAGE DESCRIPTION SYSTEM AND :
METHOD :

**DECISION ON
PETITION UNDER
37 CFR 1.47(a)**

This is a decision on applicants' "Petition Pursuant to 37 C.F.R. §1.47(a)" ("Pet.") filed on 07 June 2002.

BACKGROUND

On 28 November 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of \$130.00 pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond.

On 07 June 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, the \$130.00 petition fee; a four-month extension and \$1,440 extension fee; a declaration signed by three of the seven listed joint inventors; and copies of Federal Express tracking documents.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the \$130.00 petition fee has been paid.

With regard to item (3), applicants state that the last known addresses of the missing joint inventors are:

Chung-Sheng Li, 50 Croton Avenue, Apt 2C, Ossining NY 10562

John R. Smith, 275 W.96th Street, Apt. 15B, New York, NY 10025

Lawrence D. Bergman, 30 Saw Mill River Road, Hawthorne, NY 10532

Atul Puri, 100 Schulta-Middletown, Redbank NJ 07701

This information satisfies item (3).

Regarding item (4), applicants included a Declaration signed by three of the seven listed joint inventors, Seungyup Paek, Ana Benitez, and Shih-Fu Chang. The nonsigning joint inventor's names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has also been satisfied.

However, applicants have not sufficiently met the requirements of item (2).

Applicants' burden in proving that an inventor cannot be located pursuant to item (2) is explained in section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) which states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.

In the instant petition, applicants state that counsel sent "the Combined Declaration and Power of Attorney document by Federal Express to the missing inventors to their last known address." Pet. at ¶ 2. Applicants included copies of the Federal Express tracking documents with the instant petition as required.

However, it does not appear that Mr. Ragusa has the requisite firsthand knowledge of the facts as required by the MPEP. As stated above, a declaration by a person having firsthand knowledge of the steps taken to locate the nonsigning joint inventors are required. In the petition, counsel claims that "[a]pplicants Seungyup Paek, Ana Benitez, and Shih-Fu Chang are still actively trying to contact the missing

inventors by Internet searches, as well as contacting the missing inventors' last known employers to ascertain the whereabouts of the missing inventors." Id. Therefore, an affidavit or declaration by Seungyup Paek, Ana Benitez, and Shih-Fu Chang should be submitted detailing the steps used to locate the four missing joint inventors.

In addition to these declarations, all documentary evidence received in conjunction with the search for the missing nonsigning joint inventors such as paper copies of any internet searches and copies of letters or emails to and from the nonsigning joint inventors' former employer should be provided in any renewed petition.

Item (2) is not satisfied. Thus, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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